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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,795	06/19/2001	Ronald J. Scherer	3616.177US12	4387

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MERCHANT & GOULD PC  
P.O. BOX 2903  
MINNEAPOLIS, MN 55402-0903

EXAMINER

LEE, JONG SUK

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 11/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/884,795

Applicant(s)

SCHERER ET AL.

Examiner

Jong-Suk (James) Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 24-28 and 43-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 29-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5,9. 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

1. Claim 22 drawn to a wall from a plurality of masonry blocks according to claim 1, has been treated as an independent claim written in shorthand form.

***Election/Restriction***

2. Applicant's election with traverse of Group I directed to claims 1-23 and 29-42 in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

3. Claims 24-28 and 43-53 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "a locator lip or flange 126" as described on page 23, line 26 in the specification. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the

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1 application. The objection to the drawings will not be held in abeyance.

2  
3 *Specification*

4 5. The disclosure is objected to because of the following informalities:

5 In the first paragraph, on page 1, --US 6,321,740-- should be inserted after "filed June 11,  
6 1999" in order to clarify the status of the parent application.

7 Appropriate correction is required.

8  
9 *Claim Rejections - 35 USC § 102*

10 6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the  
11 basis for the rejections under this section made in this Office action:

12 A person shall be entitled to a patent unless --

13 (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or  
14 on sale in this country, more than one year prior to the date of application for patent in the United States.

15  
16 7. Claims 29-32, 37-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Dean,  
17 Jr. (US 4,335,549).

18 Dean, Jr. discloses a block split assembly and method including a masonry block (14)  
19 being produced from a molded work piece being split in a block splitter (110) having a splitting  
20 line, the block splitter comprising a first splitting assembly including a cutting edge and blade  
21 surface with an acute angles as depicted in Fig. 10, the cutting edge further comprising a plurality

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1 of projections (121, 122, 123) disposed at least one side of the splitting line, a second splitting  
2 assembly opposed to the first splitting assembly, the second splitting assembly including a plurality  
3 of projections (114, 115, 116) positioned so that they engage the work piece during the splitting  
4 operation whereby the masonry block including an opposed pair of irregular edges, a surface of  
5 the masonry block having a textured portion on a side surface (see Figs. 1-12; col.4, lines 12-68;  
6 col.5, lines 1-50; col.7, lines 3-68; col.8, lines 1-13).

7  
8 ***Claim Rejections - 35 USC § 103***

9 8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness  
10 rejections set forth in this Office action:

11 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in  
12 section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are  
13 such that the subject matter as a whole would have been obvious at the time the invention was made to a person  
14 having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the  
15 manner in which the invention was made.

16 This application currently names joint inventors. In considering patentability of the claims  
17 under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was  
18 commonly owned at the time any inventions covered therein were made absent any evidence to  
19 the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor  
20 and invention dates of each claim that was not commonly owned at the time a later invention was  
21 made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35  
22 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

23  
24 9. Claims 1-14, 19, 22, 23 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable  
25 over Dean, Jr. in view of Sievert (US 6,082,057). The teachings of Dean, Jr. have been discussed

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1 above.

2           However, Dean, Jr. fails to disclose or fairly suggest a locator protrusion/lip integrally  
3 formed on a bottom surface of the block and the rounded/radiused upper and lower edges  
4 between the top, front and bottom surfaces.

5           Sievert discloses a splitting technique with a masonry block (11) comprising of: a top,  
6 bottom, front and rear surface, an upper edge between the top and front surface, a lower edge  
7 between the front and bottom surface, the front face (146, 148) being split with the split line (12)  
8 and being generally rounded/radiused and roughened, and a locator protrusion/lip (18, 20) as  
9 depicted in Figs.1-3, a wall formed from a plurality of masonry blocks as depicted in Fig. 5 (see  
10 Figs. 1-7; col.3, lines 8-67; col.4, lines 1-62).

11           Therefore, in view of Sievert, it would have been obvious to one of the ordinary skill in  
12 the art at the time the invention was made to replace the block of Dean, Jr. with the block as  
13 taught by Sievert in order to produce the rounded front surface with the lip locator at the rear  
14 bottom portion of the block for the retaining wall.

15           With respect to the mottling of the front surface of the block, it would have been obvious  
16 to one of the ordinary skill in the art at the time the invention was made to have mottled surface  
17 by splitting the block with the blade to produce the roughened surface because the broken surface  
18 having a different facing angles to the vertical plane.

19

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10. Claims 15-18, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dean, Jr. as modified by Sievert, as applied to claim 1, and further in view of Fletcher et al. (US 3,809,049). The teachings of Dean, Jr. modified by Sievert have been discussed above.

However, the teachings of Dean, Jr. modified by Sievert fails to disclose or fairly suggest the projections being cylindrical with a rounded tip and the tip being positioned above or below the top of the blade. Fletcher et al. discloses an apparatus for cutting a rough-surfaced stone bodies comprising of a blade having a plurality of projections being shaped to be cylindrical (25) with a rounded tip (82), the projections being positioned below or above the average splitting line as depicted in Fig. 2 (see Figs. 1-8; col.3, lines 5-68; col.4, lines 1-62; col.6, lines 7-43).

Therefore, in view of Fletcher et al., it would have been obvious to one of the ordinary skill in the art at the time the invention was made to further modify the projections of the cutting blade of Dean, Jr., as modified by Sievert, by replacing with the cylindrical shaped projections with a rounded tip portion in order to enhance the cutting ability while the splitter assembly being used for cutting the rough-top-surfaced block.

With respect to the pyramidal shaped projections, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the rounded tip of the projections of Dean, Jr. modified by Sievert and Fletcher et al. by cutting the side of the tip in order to sharpen the projection's tip for better cutting the masonry block.

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*Obviousness-Type Double Patenting*

11. The nonstatutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and © may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-23 and 29-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-55 of U.S. Patent No. 6,321,740 in view of Sievert (US 6,082,057).

The '740 Patent discloses a masonry block splitter comprising first and second opposed splitting blade assemblies, the first splitting blade assembly comprising a first splitting blade comprising of a plurality of projections adjacent the first splitting blade first side and a plurality of projections adjacent the first splitting blade second side, the second blade assembly comprising a



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1 plurality of projections....., the projections being positioned so that they travel into a work piece  
2 as it is split into at least two pieces by the masonry block splitter, whereby the projections  
3 contribute to the formation of irregular split edges and surfaces on the split pieces (claims 1 and  
4 16, col.5, lines 2-11 and col.6, lines 10-24), the projections have a rounded shape or pyramidal  
5 shape (claims 2, 19 and 20; col.5 and col.6), one or more projections extending about 1/8 to 3/8  
6 of an inch beyond the first blade (claim 6, col.5, lines 20-23) for example.

7           However, the '740 Patent fails to disclose or fairly suggest the masonry block with a  
8 locator protrusion/lip integrally formed on a bottom surface of the block and the rounded/radiused  
9 upper and lower edges between the top, front and bottom surfaces.

10           Sievert discloses a splitting technique with a masonry block (11) comprising of: a top,  
11 bottom, front and rear surface, an upper edge between the top and front surface, a lower edge  
12 between the front and bottom surface, the front face (146, 148) being split with the split line (12)  
13 and being generally rounded/radiused and roughened, and a locator protrusion/lip (18, 20) as  
14 depicted in Figs.1-3, a wall formed from a plurality of masonry blocks as depicted in Fig. 5 as  
15 discussed above.

16           Therefore, in view of Sievert, it would have been obvious to one of the ordinary skill in  
17 the art at the time the invention was made to include the masonry block as taught by Sievert to the  
18 splitting assembly in order to produce the rounded front surface with the lip locator at the rear  
19 bottom portion of the block for the retaining wall.

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*Provisional Obviousness-Type Double Patenting*

13. Claims 1-23 and 29-42 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-61 of copending Application No. 09/691,864 in view of Sievert (US 6,082,057).

The '864 Application discloses a masonry block splitter comprising first and second opposed splitting blade assemblies, the first blade assembly comprising a first splitting blade having a cutting edge with first and second sides, the first blade assembly comprising a plurality of projections adjacent the first cutting edge first side and a plurality of projections adjacent the first cutting edge second side, the second blade assembly comprising a second splitting blade having a cutting edge with first and second sides, the second blade assembly comprising a plurality of projection adjacent.....(claims 1 and 33); the projections being a rounded shape or pyramidal shape (claims 2 and 3), the splitting blade extending at an angle between 0 to 30 degrees (claim 32); one or more projections extending about 1/8 to 3/8 of an inch beyond the first blade (claim 8) for example.

However, the '864 Application fails to disclose or fairly suggest the masonry block with a locator protrusion/lip integrally formed on a bottom surface of the block and the rounded/radiused upper and lower edges between the top, front and bottom surfaces.

Sievert discloses a splitting technique with a masonry block (11) comprising of: a top, bottom, front and rear surface, an upper edge between the top and front surface, a lower edge

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1 between the front and bottom surface, the front face (146, 148) being split with the split line (12)  
 2 and being generally rounded/radiused and roughened, and a locator protrusion/lip (18, 20) as  
 3 depicted in Figs.1-3, a wall formed from a plurality of masonry blocks as depicted in Fig. 5 as  
 4 discussed above.

5 Therefore, in view of Sievert, it would have been obvious to one of the ordinary skill in  
 6 the art at the time the invention was made to include the masonry block as taught by Sievert to the  
 7 splitting assembly in order to produce the rounded front surface with the lip locator at the rear  
 8 bottom portion of the block for the retaining wall.

9  
 10 This is a provisional obviousness-type double patenting rejection because the conflicting  
 11 claims have not in fact been patented.

12  
 13 14. The **provisional obviousness-Type double patenting** rejection is based on a judicially  
 14 established based upon public policy is primarily intended to prevent the prolongation of the  
 15 patent term by prohibiting claims in a second patent not patentably distinct from claims in a first  
 16 patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). A timely filed terminal  
 17 disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional  
 18 rejection on this ground provided the conflicting application of patent is shown to be commonly  
 19 owned with this application. See 37 C.F.R. 1.78 (d).

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*Conclusion*

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Other references cited disclose a block splitting tool and a modular block wall.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jong-Suk (James) Lee whose telephone number is (703) 308-6777. The examiner can normally be reached between the hours of 6:30 AM to 3:00 PM Monday thru Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford, can be reached on (703) 308-2978. The fax phone number for this Group is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

J. Lee /jjl  
November 20, 2002



**Jong-Suk (James) Lee**  
**Patent Examiner**  
**Art Unit 3673**